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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

	Application No.	Applicant(s)
	06/227,842	MISZACK, MARK
Examiner	M. A. ELLIOTT	Art Unit 1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 4/2/01.

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1 & 3 - 27 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1 & 3 - 27 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

20)  Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Affidavit under 37 CFR 1.132***

1. The affidavit under 37 CFR 1.132 filed 9/6/2001 is insufficient to overcome the rejection of claims 1 & 3-27 based upon Nagarajan et al. in view of James et al. and Crockett et al. as set forth in the last Office action because:

It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

Applicant has submitted a sales brochure which discusses commercial success, this is not an indication or a prerequisite for patentability. Additionally, alterations were made in the affidavit which were not initialed or dated.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 & 3-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagarajan et al. (US Pat. 5,824,992) in view of James et al. (US Pat. 5,192,851) and Crockett et al. (US Pat. 5,365,036).

Nagarajan et al. discloses a metal core wire with a steel sheath. The core composition is between 0.001-12 wt% of the total metal core wire. Additionally, the core contains iron powder (abstract). The oxygen content of the metal-core wire weld deposits are affected by the shielding gas. The total metal core wire compositions contain the following approximate ranges, C (0.005-0.15 wt%), Mn (1.0-4.0 wt%) and Si (0.3-2.5 wt%) by total weight of the wire. The steel sheath contains the following approximate ranges, Mn (0.1-1.1 wt%), C(0.005-0.15 wt%), Ti, B, and the balance Fe. The metal core contains approximately C(0.005-0.030 wt%), Mn (0.5-2.5 wt%), Si (0.2-1.2 wt%), Ti (0.001-0.100 wt%), Fe (0.1-10.0 wt%) which yields the following combined compositions: Fe-Mn (0.6-12.5 wt%), Fe-Si (0.3-13.2 wt%), and Fe-Ti (0.101-10.1 wt%).

Analysis of the final weld deposit yields the presence of nitrogen (col. 2, lines 4-6; col. 4, lines 1-65; col. 5, lines 1-65; col. 6, lines 1-65; col.7, lines 1-65 & col. 8, lines 1-45). Furthermore, it is well known in the art that steels contain trace amounts of nitrogen, phosphorous and sulfur, that is, P ( $\leq$  0.04 wt%), S ( $\leq$  0.03 wt%) and N ( $\leq$  0.2 wt%) (ASM Handbooks). Nagarajan et al. does not teach the presence of aluminum and silicon in the steel sheath, the composition of the shielding gas, the exact core weight percent of the total wire or fume reduction.

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James et al. discloses an electrode wire for electric arc welding. The core contains Mn, Si and the remainder of the core contains fused mixed oxide, desired alloying components and iron powder (abstract). The oxides contain  $\text{Al}_2\text{O}_3$ . The proportion of the core is 15 to 28 wt% of the total wire. Shielding gas is an argon-carbon dioxide mixture containing 2 to 25 %  $\text{CO}_2$ . (Col. 1, lines 65-66; col. 2, lines 13-17) It would have been obvious to one of ordinary skill in the art at the time of the invention to use the Si and Al and core composition as disclosed by James et al. in the Nagarajan et al. welding electrode because of strength enhancement due to the presence of aluminum and silicon.

Crockett et al. discloses a gas shielded electrode. The wire has a ferrous sheath and the core contains aluminum, titanium, carbon, manganese and silicon. The presence of aluminum reduces the fume amounts during welding. Solid wire welding had reduced fume generation with the presence of aluminum (abstract & col. 3, lines 25-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to measure fume generation as taught by Crockett et al. for the Nagarajan et al. wire because it would characterize the welding wire and deposit more completely.

If the range of the prior art and claimed range do not overlap, obviousness still exists if the ranges are close enough that one would not expect a difference in properties. In re Woodruff 16 USPQ 2d 1934; Titanium Metals Corp. v. Banner 227 USP 773 (Fed. Cir. 1985); In re Aller 105 USPQ 233. Furthermore, the selection of reaction parameters, such as gaseous environments, would have been obvious. It is well settled that where patentability is predicated upon a change in

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a condition of prior art process, such as gaseous environments (argon and carbon dioxide concentrations), the change must be at least "critical", that is, it must lead to a new and unexpected result. The applicant has the burden of providing such proof of criticality. In re Aller 105 USPQ 233, 255 (CCPA 1955).

***Response to Amendment***

4. Upon carefully reviewing Applicant's arguments filed September 6, 2001 the Examiner acknowledges the amendments to claims 1, 3, 8, 11-13, 15, 22 & 26-27.

5. Applicant's arguments filed September 6, 2001 (paper # 9) have been fully considered but they are not persuasive.

Applicant argues that Nagarajan discloses a sheath with a carbon content as low as 0.005% merely as background and not as a specific embodiment, and hence the reference is not valid. The examiner respectfully disagrees because the teachings of a reference must be taken in its entirety and not limited to only specific embodiments.

Additionally, the applicant argues that James does not disclose fume reduction. The examiner agrees that James does not teach fume reduction. The examiner used Crockett to teach fume reduction, not James. Furthermore, the 35 USC 103 claim rejections were based on a

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combination of art, that is, instant claims were unpatentable over Nagarajan et al. in view of James et al. and Crockett et al. Furthermore, unobviousness cannot be established by attacking the references individually when the rejection is based on a combination of references. In re Novak 16 USPQ 2d 2041, 2043 (Fed. Cir., BPAI 1989); In re Merck & Co. 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); In re Keller 208 USPQ 871 (CCPA 1981); *Ex parte Varga* 189 USPQ 204; *Ex parte Campbell* 172 USPQ 91; In re Scheckler 168 USPQ 716 (CCPA 1971); In re Young 159 USPQ 725; In re Lyons 150 USPQ 741.

Applicant argues that the reliance on Crockett to teach fume generation indicates that Nagarajan alone does not support the rejection. The examiner respectfully notes that the rejection is a 35 USC 103 rejection which is based on a combination of art, that is, instant claims were unpatentable over Nagarajan et al. in view of James et al. and Crockett et al. Furthermore, unobviousness cannot be established by attacking the references individually when the rejection is based on a combination of references. In re Novak 16 USPQ 2d 2041, 2043 (Fed. Cir., BPAI 1989); In re Merck & Co. 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); In re Keller 208 USPQ 871 (CCPA 1981); *Ex parte Varga* 189 USPQ 204; *Ex parte Campbell* 172 USPQ 91; In re Scheckler 168 USPQ 716 (CCPA 1971); In re Young 159 USPQ 725; In re Lyons 150 USPQ 741.

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***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bushey et al. (US Pat. 5,095,191); Keegan et al. (US Pat. 5,857,141).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is (703) 308-0092. The examiner can normally be reached Monday to Friday from 6:30 AM to 3:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn, can be reached on (703) 308-3318. The fax number for the group is (703) 872-9386.

Any inquiry of general nature to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0661.



M. ALEXANDRA ELVE  
PRIMARY EXAMINER

October 21, 2001.